

REMARKS

This Amendment is filed in response to the Office Action mailed December 17, 2004, in which the Examiner (A) enters a restriction requirement between claims 1-21, on one hand, and claims 22-26, on the other; (B) rejects what appears to be claims 1-21 under Section 102 over U.S. Patent No. 1,611,541 to McCrocklin et al.; and (C) rejects claims 22-26 under Section 103 over U.S. Patent No. 6,503,137 to Maille. The applicants thank the Examiner for conducting the search and examining all pending claims. Claims 1, 12, 20 and 22 have been amended above, and applicants respectfully request that they be reconsidered and allowed.

A. Restriction Requirement

The Examining Attorney restricts the pending claims between claims 1-21, on one hand, and claims 22-26, on the other, on the grounds that the former set is directed toward a device and the latter set is drawn to a method. The Examiner asserts that the inventions are distinct because “the apparatus can be used to operate on a human body.” (Applicants note that the preamble for the only independent method claim expressly recites “a method for dressing a piece of shellfish.” Thus, the method is not intended for use on a human body.)

Applicants respectfully assert that, not only are the two sets of claims directed toward a single invention, but, more particularly, they are directed toward a device and the use of the same device. As such, searching out one set of claims will supplant the need to search out the other. As indicated by the Examiner, all pending claims fall into class 452, subclass 102. And notably, the Examiner has already searched and examined all pending claims, issuing a Section 102 rejection for the first set and a Section 103 rejection for the second set. Thus, there will be no prejudice or additional burden to the Examiner or the Office if both sets of claims are retained in the present application.

Applicants therefore have maintained all pending claims in the present application. Should the Examiner not withdraw the restriction requirement, the applicants elect claims 1-21 for further prosecution in the present application, without prejudice to future prosecution of the non-elected claims.

B. Response to Section 102 Rejection

The Examiner rejects claims 1-21 under Section 102 on the grounds that U.S. Patent No. 1,611,541 to McCrocklin et al. discloses every element of each of these claims. The applicants respectfully request that the Examiner reconsider the currently pending claims and the following comments and withdraw the rejection.

The McCrocklin et al. device is directed toward an egg breaker made up essentially of handles 7 and a pair of cups C, connected together by a set of interconnected arms 6, 10, 11. The handles 7 are manipulated by a user and, through operation of the arms 6, 10, 11, the cups C open or close to retain an egg therebetween. Other aspects of the invention can be manipulated to crack the egg and retain the broken egg shells within the cups C; however, those features are not relevant to this analysis. Because the device is designed to retain and crack eggs, the cups C are shaped and sized to retain an egg therebetween.

The present invention is directed toward a device for being inserted into a piece of shellfish, and for cracking the shellfish from the inside. As such, the claims recite a device having a distal end that is sized and shaped to be inserted into a piece of shellfish. As recited in claim 1, a working portion of the device has “a first end coupled to the handle portion and terminating at an opposing second end in an insertion tip sized and shaped to be insertable into the piece of shellfish.” As recited in claim 12, the device incorporates a pair of arms and wherein “the distal ends of the arms terminat[e] coincident with a terminal end of the device to facilitate insertion of the device into the piece of shellfish.” As recited in claim 20, the device has first and second blades, the distal end of each blade “being sized and shaped to facilitate its insertion into the piece of shellfish.” Thus, in each claim, the inventive device terminates at its distal end in a portion that is configured to be inserted into the shellfish.

The claimed invention is patentable under Sections 102 and 103 over McCrocklin et al. because this reference fails to teach or suggest several elements of these claims. For example, the reference fails to teach or suggest a device having a distal end that is insertable into a piece of shellfish. Instead, the distal end of the McCrocklin et al. device is greatly enlarged and blunt, allowing it to receive an egg. Such a distal end could not be inserted into a piece of shellfish, and is certainly not designed to facilitate its insertion into anything. Further, the

McCrocklin et al. device does not terminate at the arms 10, but instead continues considerably beyond that point. On the contrary, the McCrocklin et al. device teaches away from the claimed devices: the McCrocklin et al. device would not function if it were cut off at the arms 10. Accordingly, claims 1, 12, and 20 are patentable under Sections 102 and 103 over McCrocklin et al. Likewise, claims 2-11, claims 13-19, and claim 21 are patentable because they depend from allowable independent claims 1, 12 and 20, respectively.

C. Response to Section 103 Rejection

The Examiner rejects claims 22-26 on the grounds that each of these claims is obvious in view of U.S. Patent No. 6,503,137. The applicants respectfully request that the Examiner reconsider the currently pending claims and the following comments and withdraw the rejection.

The Maille reference is directed toward a device having two interconnected bars 12,14, and wherein the distal ends of the two bars are spread apart before one of the two bars is inserted into the piece of shellfish. Once the bar is inside the shellfish, the device is manipulated such that the two distal bars are aligned, moving toward each other laterally in the process. This process cuts a portion of the shell, similar to the action of a pair of scissors. The process is then repeated along the length of the shellfish until the shell is completely cut.

In the claimed method, the device has at least four interconnected linkages, at least two of the linkages are inserted into the piece of shellfish, and the linkages are moved apart from each other to cut the shell. The device can then be pulled from the shell to created an elongated cut in the shell.

The claimed method is patentable under Section 103 over the Maille reference because this reference fails to teach or suggest several elements of these claims. For example, while the claimed method recites inserting at least two linkages into the shellfish, the Maille reference teaches the insertion of only one. The claimed method recites a device having four interconnected linkages, while the Maille device incorporates only two. Also, the claimed method recites spreading the linkages inside the shellfish, while the Maille device teaches

aligning the linkages by moving them together. Accordingly, claim 22 is patentable under Section 103 over the Maille reference, as are claims 23-26, which depend from claim 22.

D. Conclusion

As indicated above, applicants assert that the pending claims are in condition for allowance, and respectfully request that the Examiner reconsider and withdraw all rejections. Further, applicants assert that the claims are all directed toward a single invention and, thus, the restriction requirement should also be withdrawn. The Examiner is invited to contact the undersigned by telephone with any questions or comments, or to discuss any remaining issues in the present case.

Respectfully submitted,
Seed Intellectual Property Law Group PLLC



Kevin S. Costanza
Registration No. 37,801

KSC:ljs
Enclosure:
Postcard

701 Fifth Avenue, Suite 6300
Seattle, Washington 98104-7092
Phone: (206) 622-4900
Fax: (206) 682-6031